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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,970	02/20/2002	Nitzan Arazi	2098/8	3804

7590 08/12/2004

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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 08/12/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,970

Applicant(s)

ARAZI ET AL.

Examiner

Joy K Contee

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1,3,6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1,3,6 and 7 are objected to because of the following informalities:
using capital letters in terminology such as "Base Stations" is not necessary in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Heineck et al. (Heineck), U.S. Patent No. 5,519,759.

Regarding claim 1, Heineck discloses in a wireless communication system comprising a base station connected with a mobile unit, a method of synchronizing at least one neighboring Base Station to the Base Station connected with the mobile unit comprising:

from the base station connected with the mobile unit (i.e., reads on wireless communication unit in the communication range of base station), sending call parameters (i.e., reads on start information or radio transmission conditions) and rough synchronization information (i.e., reads on synchronization

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information) to the at least one neighboring base station (col. 6, lines 28-31 and col. 7, lines 25-55 and col. 8, lines 57-65); and

at the at least one neighboring base station, inherently monitoring transmissions (i.e., reads on able to receive synchronization information) of at least one of:

the base station connected with the mobile unit (col. 6, lines 28-31); the mobile unit; and a beacon signal from a beacon transmitter which is within range of the at least one neighboring base station and the base station connected with the mobile unit.

Regarding claim 2, Heineck further discloses a method, according to claim 1, wherein the mobile unit is a device selected from the group consisting of: telephone handset, standard cordless telephone handset (i.e., reads on terminal equipment for use with DECT Standard) (see col. 3, lines 35-52); cellular telephone handset (i.e., wireless communication terminal equipment) (see col. 6, lines 6, lines 28-31), personal data device, personal digital assistant (PDA), computer, laptop computer, e-mail server, a device utilizing point-to-point protocol (PPP) to the Internet via a central remote access server, a headset, a personal server, a wearable computer, a wireless camera, and a mobile music player.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

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Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-10 of copending Application No. US 2002/0147016 ('016). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 7-10 of '016 encompass the scope of the instant application.

The instant application in independent claims 1 and 3, generally describe in a wireless communication system comprising a base station connected with a mobile unit, a method of synchronizing at least one neighboring base station to the base station connected with the mobile unit comprising: from the base station connected with the mobile unit, sending call parameters and rough synchronization information to the neighboring base station and at that neighboring base station, monitoring transmissions of at least one of base station connected with the mobile unit (i.e., performing a wide range search for "target" signals having the correct timing for a mobile unit based on rough synchronization information); a mobile station; and a beacon signal from a beacon transmitter. In contrast independent claim 1 of '016 discloses the same

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generally but more specifically claims "rough TOD and a device address for a mobile unit" included in the synchronization information transmitted from the base station connected to the mobile station. Further '016 discloses at least one neighboring base station checking for a signal transmitted by the mobile unit.

Omission of element and its function in combination is obvious expedient if remaining elements perform same function as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wheatley III et al., U.S. Patent No. 6,151,311, discloses a mobile station assisted timing synchronization in a CDMA communication system.

Tiedemann, Jr. et al., U.S. Patent Application Pub. No. 2004/0085938, discloses a method for handoff between an asynchronous CDMA base station and a synchronous CDMA base station.

Terasawa, U.S. Patent Application Pub. No. 2002/0122396, discloses a handoff control in an asynchronous CDMA system.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is

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703-308-0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

August 7, 2004


8/9/04
LESTER G. KINCAID
PRIMARY EXAMINER